

REMARKS

The Office Action of April 18, 2008 requires an election under 35 U.S.C. §§ 121 and 372 from among the following:

- I Claims 1-19, drawn to a chemical compound, a pharmaceutical composition, and a process for preparing a chemical compound of formula (I);
- II Claims 20-22, drawn to use claims using a chemical compound of formula (I);
- III Claim 23, drawn to a method for selectively inhibiting cyclooxygenase-2 using a chemical compound of formula (I)

Group I, claims 1-19, is elected with traverse for further prosecution in this application. Applicants reserve the right to file divisional applications to non-elected subject matter.

The Office Action also required a species election for the radicals defined by R₁, R₂, X, and Y.

Applicants elect the species wherein R₁ and R₂ may be the same or different but each independently represents substituted or unsubstituted phenyl, and the species wherein X and Y are the same and each independently represents an N

Claims 1 and 17 are generic to all species of radicals defined by R₁, R₂, X, and Y. Applicants understand that, upon the allowance of a generic claim, claims to additional species will be considered, as provided by 37 C.F.R. 1.141. Applicants also understand that the Examiner can broaden the search to include other species, *e.g.*, upon determining that a species is allowable, or when there is a relationship among the species and/or number of species is not too great.

Upon allowance of the group I product claims, Applicants request rejoinder under MPEP 821.04 of the group II and group III process claims, which contain all of the limitations of the group I product claims.

The Office Action alleges that the claims of the present invention are not linked so as to form a single inventive concept under PCT Rule 13.1. Allegedly, the claims of the present invention lack the same or corresponding special technical features as required under PCT Rule 13.2 because a common structure is not present in which the utility is attributed.

As a traverse, Applicants argue that the claims of group I, II, and III all relate to the

compound represented by formula I. For instance, in the claims of group I, claims 1-3 relate to a compound represented by formula I; claims 4-16 relate to a method of preparing the compound represented by formula I; and claims 17-19 relate to a pharmaceutical composition which contains the compound of formula I. Claims 20-22 of group II relate to the use of the compound represented by formula I. Finally, claims 23-25 of group III relate to a method comprising administering the compound represented by formula I. Clearly, the claims of each group relate to the same compound represented by formula I, and thereby share a common structure.

Applicants further note that the Office Action does not comment on the novelty of the compound of formula I, which indicates that the compound qualifies as a special technical feature under PCT Rule 13.2 since it defines "a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

Therefore, considering that all of the claims share the same special technical feature and that the special technical feature is a contribution which each of the claimed inventions make over the prior art, the restriction requirement should be withdrawn.

Furthermore, Applicants traverse the species election for the radicals defined by R₁, R₂, X, and Y. Applicants assert that the R₁ and R₂ radicals of substituted or unsubstituted phenyl, pyridinyl, or pyrimidinyl, and the X and Y radicals of N or S atom are few in number and would not constitute an undue burden to the Examiner if examined together. The Examiner's attention is directed to MPEP § 803.02, which states:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. (Emphasis added.)

Thus, since these radicals are indeed few in number, Applicants respectfully submit that the election of a single radical for R₁, R₂, X, and Y be withdrawn.

Enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the Office Action has not provided the requisite showing that the special technical feature is not shared among the claims of groups I-III. Further, in view of the sufficiently few number of radicals

depicted in R1, R2, X, and Y, search and examination of each of the claimed combinations can be made without undue burden on the Examiner. All of the preceding, therefore, mitigates against restriction.

In view of the above, reconsideration and withdrawal of the Requirement for Restriction are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: 

Ronald R. Santucci
Reg. No. 28,988
Telephone: (212) 588-0800
Facsimile: (212) 588-0500